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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005				ODLAND, KATHRYN P
ART UNIT		PAPER NUMBER		
		3743		

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/725,048	BAZIN ET AL.
	Examiner Kathryn Odland	Art Unit 3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 3-63 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/13/04.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

This is a response to the amendment dated April 28, 2004. Claims 1 and 3-63 are pending.

***Information Disclosure Statement***

1. It appears that an IDS was submitted April 26, 2004. However, the 1449 is missing from the file. A resubmission is requested. Also, English translations and/or equivalents are requested for the foreign documents cited in the IDS dated, January 13, 2004. Upon receipt of translation/equivalent, they will be considered.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 21, 22, 49, 50, 58 and 60 as rejected over 35 U.S.C. 102(b) over Groh as well as the 35 U.S.C. 103(a) rejection regarding claims 1, 3, 21-23, 49-51 and 53-58 based on Herzog in view of Dusserre and further in view of Groh and the 35 U.S.C. 103(a) rejection regarding claims 1, 3, 49, 50 and 60 based on Rigg et al. in view of Dusserre and further in view of Groh have been considered but are moot in view of the new ground(s) of rejection.

Applicant has amended claim 1 to include the limitation, "wherein the transfer member includes adhesive material provided on a backing, the adhesive material of the transfer member being in contact with skin while the adhesive material is on the backing and the transfer member being removed from the skin to transfer cells from the skin of the individual to the transfer member." In light of applicant's amendments, a 35 U.S.C. 103(a) rejection has been applied to claim 1 and corresponding dependent claims. This rejection is based Groh and further in view of Kawashima et al. Kawashima et al. disclose tacky tape as

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a transfer member for observing skin through a scanner. Therefore, it would be obvious to one with ordinary skill in the art to provide the system of Groh with tacky tape for many reasons, such as the tacky tape of Kawashima et al. allows for a one step skin removal process vs. Groh which requires a two step process: first applying the glue and then the backing. Thus, this modification makes the process faster and easier to perform. Furthermore, the transfer member of Kawashima et al. can also be construed as an obvious alternative to the transfer member of Groh since the same function of obtaining a skin sample is achieved.

3. Applicant's arguments filed April 28, 2004 have been fully considered but they are not persuasive.

Regarding applicant's arguments regarding the rejections under 35 U.S.C. 102 (a and/or e) based on Stess et al., the rejections of claims 1, 21, 22, 30, 50, 51, 54, 60, and 63 have been withdrawn. Applicant's arguments regarding claim 11 have been carefully considered. However, the examiner respectfully disagrees. Applicant argues, "Stess does not disclose or suggest 'placing moldable material in contact with the skin of the individual to produce on the moldable material, the surface profile on the skin. In the Office Action, the Examiner apparently asserted that Stess's impression shirt somehow corresponds to a transfer member....Stess discloses mounting the impression shirt over a release shirt without contacting the impression shirt with the skin." However, Stess et al. do disclose moldable material in contact with the skin. To reiterate that stated in the Office Action dated January 28, 2004, "column 5, lines 37-45 recites, 'If thermal insulating layer is provided as shirt or layer 25, it will **bond** to the resin-saturated layer impregnated impression shirt layer 27 during hardening of the resin. The next step of the method of the present invention is to

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remove the impression shirt from the patient.” The two layers are bonded together to form one. Therefore, portion of this integral moldable material is in contact with the skin.

Regarding applicant arguments regarding the rejections based on 35 U.S.C. 102(b) based on Groh. The rejections for claim 1 and corresponding dependent claims have been changed to a 35 U.S.C 103(a) rejection in light of applicant’s amendments. Regarding the arguments with respect to claim 52, the examiner respectfully disagrees. Applicant is directed to column 5 of Groh, which discusses grey level adjustment ranges, etc; thus, calibration where the calibration member would necessarily be one of a predetermined size and color. Calibration is defined as to check, adjust, or determine by comparison with a standard according to The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company. There is a standard such as the range of 50 to 63 as recited in column 5, lines 25-30 and the hardware and software compare the ranges according to the standard.

Regarding the arguments based on the 35 U.S.C 103(a) rejections based on Scott et al. in view of Chung et al., the examiner respectfully disagrees. Applicant argues, “Scott discloses a fingerprint scanner. There is simply no reason why one of ordinary skill in the art would have been motivated to use Scott’s fingerprint scanner for anything other than finger prints.” However, it is well known to expand fingerprinting to include other body parts such as toes. For example, when infants are born/pass away, finger and toe prints are taken. An article by Susan Holtstine has been provided for extrinsic evidence. This article discusses that fingerprints and toe prints of her baby were taken. Thus, it would be obvious, and often necessary to scan other body components such as toes as one method to obtain both fingerprints and toe prints. Further, Chung et al. clearly disclose an adhesive

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sheet/transfer member for obtaining data to be analyzed such as on the palms, foot soles, and toes. Applicant also argues, that Scott does not disclose or suggest, "scanning [a] transfer image." However, fingerprints will remain on the platen 72 and applicant clearly discloses that as a possible transfer member as discussed above. Moreover, Scott et al. discuss calibration in column 5, lines 19-30 as stated in the Office Action dated January 28, 2004 and the definition of calibration is discussed above.

Regarding applicants arguments concerning the 35 U.S.C. 103(a) based on Herzog in view of Dusserre and further in view of Groh, the examiner respectfully disagrees. Applicant argues, "Herzog's only disclosure relating to scanning concerns the use of scanner 16 to scan 'additional documents, reports, graphics and/or films' and it would not be within the scope of the invention to use the scanner to obtain human scanning information." An Internet article of a presentation by La Rosa has also been provided as extrinsic evidence in support of the obviousness to use flatbed scanners to obtain human scanning information. The article states that it is known to use an HP scanner to scan glass slides. Additionally, an article entitled, "MU unveils pilot program for distance plant diagnosis" has been provided as extrinsic evidence showing it would be obvious to use a flatbed scanner for remote diagnosis. This article discusses the benefits of a flatbed scanner for cost efficiency and that it is similar to using a digital camera. Moreover, applicant is directed to the Office Action dated January 28, 2004 where the Groh reference was relied upon for the teaching of a transfer member to obtain transfer information to place on the scanner as an obvious variance to a digital photograph. Further, applicant is directed to the current application specification where numerous transfer members and external portions are disclosed in equivalence.

Regarding applicant's argument as to the 35 U.S.C. 103(a) rejections based on Rigg et al. in view of Dusserre and further in view of Groh, the examiner respectfully disagrees.

Rigg et al. disclose remote skin analysis. Dusserre teaches remote diagnosis/telemetry using digital images/optical image scanning. Therefore, there is clear motivation to expand the system to include digital image scanning for the purpose of enhanced image quality.

Further, Groh teaches obtaining data via transfer members. It would be further obvious to one with ordinary skill in the art to further expand the system to include scanning digital images obtained by using transfer members for the purpose of a more robust system.

Further, applicant is directed to the current application specification where numerous transfer members and external portions are disclosed in equivalence.

After close review of the specification, applicant discloses numerous transfer members and external areas. These numerous transfer members and external areas can be considered equivalents since no clear disclosure or arguments have been provided to demonstrate that they are distinct. The specification does not demonstrate criticality for any particular transfer member or external area; therefore, they are considered equivalent since they perform the same function of obtaining scanned information. Applicant is directed to the current application page 16, which is one of the many of examples disclosing the breadth of transfer members. Page 16 recites, "**There are many different types of transfer members that could be used. For example, the transfer member could include either adhesive material provided on a backing, a sheet of absorbent material, a piece of fabric, an article of fabric clothing (i.e., a blouse), a piece of moldable material, a hair brush, or comb, or even a portion of the scanner, 12, such as a window defining a scanning region 21, as shown in Fig.5.**"

The rejections are reiterated below and tailored accordingly.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 11 is rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Stess et al. in US Patent No. 6,533,971.

Regarding claim 11, Stess et al. disclose a process for acquiring scanned image data relating to an external body portion via placing a transfer member in contact with an external body portion of an individual so as to obtain a transfer image on the transfer member, wherein the transfer image is present on the transfer member after the transfer member and the external body portion are out of contact with one another, wherein the transfer image is not a fingerprint or fingerprints, wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth, as recited in column 3, lines 20-30, column 5, lines 40-65 and column 6, lines 5-15; and scanning the transfer image with an optical scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion and/or at least one product applied to the external body portion, as recited in column 6, lines 10-15., as well as, a transfer member that is a moldable material and wherein the process includes placing moldable material in contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin, as recited in column 5 and discussed at length in the Office Action dated January 28, 2004.

6. Claims 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Groh in US Patent No. 5,343,536.

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Regarding claim 52, Groh discloses a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, via placing a transfer member (such as 11 with associated components) in contact with an external portion of an individual (15) so as to obtain a transfer image (such as a sample 16) on the transfer member, wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another, wherein the transfer image is not a fingerprint or fingerprints, and wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion, as recited in column 4, where optical is considered light and column 4, lines 47-65 recite image analysis using scanning where light would necessarily be involved, as well as, a transfer member that includes adhesive (12) material provided on a backing, the adhesive material of the transfer member being placed in contact with skin and the transfer member being removed from the skin to transfer cells from the skin of the individual to the transfer member, as recited in column 4, as well as, a calibration member having one of a predetermined size and a predetermined color, as recited in columns 5 and 6, and further discussed above in the Response to Arguments section.

Regarding claim 53, Groh discloses that as applied to claim 53, as well as, obtaining scanned image data relating to multiple scanned images, as recited in columns 4-6.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claims 1, 21, 22, 49, 50, 58, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groh US Patent No. 5,343,536 in view of Kawashima et al. in JP407274996.

Regarding claim 1, Groh discloses a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, via placing a transfer member (such as 11 with associated components) in contact with an external portion of an individual (15) so as to obtain a transfer image (such as a sample 16) on the transfer member, wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another, wherein the transfer image is not a fingerprint or fingerprints, and wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion, as recited in column 4, where optical is considered light and column 4, lines 47-65 recite image analysis using scanning where light would necessarily be involved, as well as, a transfer member that includes adhesive (12) material provided on a backing, the adhesive material of the transfer member being placed in contact with skin and the transfer member being removed from the skin to transfer cells from the skin of the individual to the transfer member, as recited in column 4.

However, Groh does not recite a transfer member having an adhesive material provided on a backing where the adhesive material of the transfer member is placed in contact with the skin while the adhesive is on the backing. On the other hand, Kawashima et al. disclose tacky tape as a transfer member for observing skin through a scanner. Therefore, it would be obvious to one with ordinary skill in the art to provide the system of Groh with tacky tape for many reasons such the tacky tape allows for a one step process vs. Groh which requires a two step process: first applying the glue and then the slide. Thus, this modification makes the process faster and easier to perform. Furthermore, the transfer member of Kawashima et al. can also be construed as an obvious alternative to the transfer member of Groh since the same function of obtaining a skin sample is achieved.

Regarding claim 21, Groh discloses that as applied to claim 1, as well as, an external portion that includes at least one of the skin of the individual, at least one strand of hair of the individual, at least one fingernail of the individual, at least one toe nail of the individual, and at least one tooth of the individual, as recited in column 4.

Regarding claim 22, Groh discloses that as applied to claim 21, as well as, an external portion includes the skin of the individual, and wherein the external portion is located on one of the hand, foot, arm, leg, torso, and face of the individual, as recited in column 3, lines 62-68.

Regarding claim 49, Groh discloses that as applied to claim 1, as well as, scanned image data that includes data regarding color of said transfer image, as recited in column 5.

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Regarding claim 50, Groh discloses that as applied to claim 1, as well as, scanning that include emitting light from the scanner onto the transfer member, as recited in column 4.

Regarding claim 58, Groh discloses that as applied to claim 1, as well as, analyzing at least one of the external body portion and the transfer member with analysis equipment, as recited in columns 4-6.

Regarding claim 60, Groh discloses that as applied to claim 1, as well as, analyzing of the external portion that is performed by a trained person.

10. Claims 12, 14-16, 25-32, and 52 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al. in US Patent No. 6,178,255 in view of Chung et al. in US Patent No. 6,355,439.

Scott et al. disclose a process for acquiring scanned image data relating to an external body portion or a product applied to the external body portion by placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member; scanning the transfer image with an optical image scanner (10) to obtain scanned image data for an image representative of at least one characteristic of the external body portion or at least one product applied to the external body portion; a transfer member that is a window, the window being a portion of the image scanner defining a scanning region; placing the external portion of the individual in the vicinity of a scanning region of the scanner, and scanning the external portion with the image scanner; wherein the scanning of the transfer image of the transfer member and the scanning of the external portion occur one of simultaneously and one after another; an external portion of the individual is placed into contact with the scanning region of the scanner; a scanner that is a flat bed scanner and wherein the external portion of the individual is moved into contact with the scanning region; an external portion that includes at least one of the skin of the individual, at least one strand of hair of the individual, at least one fingernail of the individual, at least one toe nail of the individual, and at least one tooth of the individual; an external portion that is located on one of the hand, foot, arm, leg, torso, and face of the individual; an image scanner that is associated with a first computer (14) located at a first location; transferring the scanned image data from the first computer to a second computer located at a second location remote from the first location, as seen in figure 1; transferring that includes transmitting the scanned image data via the Internet, as seen in figure 1; storing the scanned image data on a data storage medium (26), wherein the transferring includes shipping the data storage medium to the second location, which is the way to ship a fingerprint card; displaying an image corresponding to the scanned image data and viewing the displayed image to analyze said at least one characteristic; displaying the image at the second location, as recited in column 3, lines 37-65; sending the scanned image

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data to a plurality of locations so that the at least one characteristic may be analyzed numerous times, as recited in column 3, lines 50-52; scanning that includes emitting light from the scanner onto the transfer member; a calibration member having one of a predetermined size and a predetermined color, as recited in column 5, lines 19-30; obtaining scanned image data relating to multiple scanned images; and a transfer image on the transfer member that indicates a condition of the external portion.

Although Scott et al. disclose the invention for use as a fingerprint scanner, it would be obvious to expand the system to include other body parts such as toe prints for the purpose of obtaining and database-storing data of scanned images, as further discussed above in the Response to Arguments section. Moreover, Chung et al. teach that in addition to fingerprints the toes and palms can be used to obtain DNA information from epithelial cells for the purpose of disease diagnosis, genetic identification, etc. as recited in columns 1 and 2. Thus, it would be obvious to one with ordinary skill in the art to expand the system of Scott et al. to include obtaining DNA information of other body parts such as toes.

Further, applicant argues that when placing the finger on the platen (72) that the transfer image is no longer present on the transfer member after the transfer member and the external portion are out of contact with one another. However, fingerprints remain on items after they are touched. For example, when any glass that is touched a fingerprint will remain. Therefore, a transfer image remains. Nonetheless, Chung et al. teach adhesive sheets to obtain samples and to record the image on an electronic medium. Thus, it would be further obvious to also include adhesives as transfer members in addition to the image scanner plate, as taught by Chung et al. in column 2 for the purpose of enabling the capture of additional information.

Moreover billing and questionnaires are normal business practices and it would be obvious to provide those features to the system if desired.

11. Claims 1, 11-40, 43-46, and 49-59 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzog in US Patent No. 6,241,668 in view of Dusserre in FR 2736450 and further in view of Groh in US Patent No. 5,343,536 (and further in view of Kawashima et al. regarding claim 1).

Herzog discloses a process for acquiring image data relating to an external body portion or a product applied to the external body portion by placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member; scanning the transfer image with an optical image scanner (16, 1, 2, 3, 4) to obtain scanned image data for an image representative of at least one characteristic of the external body portion or at least one product applied to the external body portion, wherein although the disclosure discusses placing documents on the scanner and using the video recorder for obtaining human images, it is within the scope of the invention to use the scanner for obtaining human scanning information.

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Telemedicine and teledermatology are extremely well known in the art. There are thousands of patents and applications not to mention the numerous articles that focus on Internet diagnosis and treatment via transmitting information over the Internet. One mere example is Dusserre who teaches transferring human data via scanning, as recited on page 4 and throughout the specification. Thus, given this knowledge and teaching of remote diagnosis, it would be obvious to one with ordinary skill in the art and within the scope of the invention to scan human scanning images. See the above discussion in the Response to Arguments section.

Herzog also discloses a transfer member that is a window, the window being a portion of the image scanner defining a scanning region and a scanner that is a flat bed scanner, as seen in figure 1; an image scanner that is associated with a first computer located at a first location, and wherein the process further comprises transferring the scanned image data from the first computer to a second computer located at a second location remote from the first location, as recited in column 4, lines 6-25; transmitting the scanned image data via the Internet, as recited in column 4, line 22; viewing the displayed image to analyze said at least one characteristic; transferring the scanned image data from the first computer to a second computer at a second location remote from the first location, wherein the image is displayed at the second location; sending the scanned image data to a plurality of locations so that the at least one characteristic may be analyzed numerous times; monitoring the status of the external portion during treatment of the external portion; providing a recommendation for a treatment of the external portion based on the monitored status, as stated in column 2, lines 1-9; providing the individual with information regarding the effectiveness of the treatment (inherent); repeating at least the acquiring (also inherent); image data that is stored in an image database, as recited in column 2, lines 48-51; determining a recommendation of at least one treatment for the external portion and providing the treatment recommendation so that the external portion of the individual may be treated according to the recommendation, as recited in column 3, lines 40-50, wherein the treatment recommendation may be a recommendation regarding use of at least one of a cosmetic product and a dermatological product; recommendation that includes providing the treatment recommendation to at least one of the individual and a treatment provider; recommendation that includes transmitting said recommendation to said at least one of the individual and the treatment provider via the Internet; image data that includes data regarding color of said transfer image; scanning that includes emitting light from the scanner onto the transfer member; a scanner is configured in the form of a scanner for scanning documents; scanned image data relating to multiple scanned images; a transfer image on the transfer member that indicates a condition of the external portion; and analyzing of the external portion is performed by a trained person.

Moreover, Groh teaches a transfer member that includes adhesive. Kawashima et al. disclose tacky tape as a transfer member for observing skin through a scanner. Therefore, it would be obvious to one with ordinary skill in the art to provide the system of Groh with tacky tape for many reasons such the tacky tape allows for a one step process vs. Groh which requires a two step process: first applying the glue and then the slide. Thus, this modification makes the process

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faster and easier to perform. Furthermore, the transfer member of Kawashima et al. can also be construed as an obvious alternative to the transfer member of Groh since the same function of obtaining a skin sample is achieved. Moreover, it would be obvious to one with ordinary skill in the art as dependent upon the desired information to be gather (since numerous external portions are disclosed as equivalents) to employ these transfer members in the system of Herzog. Therefore, it would be obvious to one with ordinary skill in the art at the time the invention was made to use an adhesive material such as tape to obtain samples to scan images of items that could not be directly placed on that scanner.

Furthermore, it is also within the scope of the invention to have a transfer member that is a sheet of material, and wherein sheet of material is placed in contact with lips of the individual and transferring a lip product from the lips to the sheet of material and a lip product that is lipstick, in which the lipstick could be used as a coloring medium to better transfer the image for medical analysis. Also, a transfer member that is a moldable material, and wherein the process includes placing the moldable material in contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin; a transfer member is one of a hair comb and a hair brush, wherein the placing of the transfer member in contact with the external body portion includes passing said one of the hair comb and the hair brush through hair, wherein the transfer image on the transfer member includes at least one of strands of hair and skin cells would also be obvious to one with ordinary skill in the art as methods to obtain scans of those types. These transfer members can be considered equivalents since the current application specification does not demonstrate the criticality to any particular transfer member. As discussed at length above in the Response to Arguments section, numerous external portions are disclosed. The current application specification does not demonstrate criticality for any particular external portion. Therefore, they are considered equivalents and dependent on the type of information desired to obtain. Moreover, any product applied would further be obvious and also dependent on the particular external portion chosen as necessary to obtain proper image scans.

Moreover, the inherent way to use a flat scanner as seen in figure 1 is to place the external portion of desired scanned image in the vicinity of a scanning region of the scanner, scanning the external portion with the image scanner, wherein it is within the scope of the invention to have a human be scanned, wherein the scanning of the transfer image of the transfer member and the scanning of the external portion occur one of simultaneously and one after another and the individual is placed into contact with the scanning region of the scanner. It is also within the scope of the invention to have the scanner be hand-held. Moreover, placing liquid between the external body portion and the scanning region, the liquid altering the index of refraction to improve visualization of said at least one characteristic and placing at least one of a dye; a pigment on the external portion to improve visualization of said at least one characteristic; a transfer member that is configured to change color in response to a condition of the external portion; and treating at least one of the transfer member and the external body portion to enhance the transfer image on the transfer member are well known techniques often used with microscopes. Therefore, it would be obvious to one with ordinary skill in the art to

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utilize them with the scanner when scanning images similar to those obtained from a microscope. Although not explicitly recited, it is within the scope of the invention to have the external portion include at least one of the skin of the individual, at least one strand of hair of the individual, at least one fingernail of the individual, and at least one toe nail of the individual; a location on one of the hand, foot, arm, leg, torso, and face of the individual; a location on the lips of the individual; at least one strand of hair that is one of a strand of hair from the scalp of the individual, an eyelash of the individual, and an eyebrow hair of the individual. Additionally, a computer that at least partially performs the determining of the treatment recommendation, the computer being located at a location remote from that of the image scanner would be feasible since the server could provide comparative data. A calibration member having one of a predetermined size and a predetermined color would also be obvious to one with ordinary skill in the art. Furthermore, analyzing at least one of the external body portion and the transfer member with analysis equipment where the analysis equipment is chosen from one of a corneometer, a dermal torque meter, an image analyzer, a PH meter, and a device for measuring hydration of the skin is also within the scope of the invention.

Additionally, billing and questionnaires are normal business practices and it would be obvious to provide those features to the system if desired.

12. Claims 1, 3-10, 12, 14-16, 18, 38-43, 46-50, and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rigg et al. in US Patent No. 5,785,960 in view of Dusserre in FR 2736450 and further in view of Groh in US Patent No. 5,343,536 (and further in view of Kawashima et al. regarding claim 1).

Rigg et al. disclose a process for acquiring scanned image data relating to an external body portion or a product applied to the external body portion, by placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member; and scanning the transfer image with an scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion, as recited in column 2. Rigg et al. also disclose a transfer member that is a window, the window being a portion of the image scanner defining a scanning region; placing the external portion of the individual in the vicinity of a scanning region of the scanner; scanning the external portion with the image scanner; a transfer member and the scanning of the external portion that occur one of simultaneously and one after another; the individual is placed into contact with the scanning region of the scanner; a scanner that is a hand-held scanner wherein the scanner is moved into contact with the external portion of the individual, as seen in figure 1; storing the scanned image data on a data storage medium (36), wherein the transferring includes shipping the data storage medium to the second location, as recited in column 5 and seen in figure 1; sending to the second location at least one of billing information and payment information; determining a recommendation of at

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least one treatment for the external portion; providing the treatment recommendation so that the external portion of the individual may be treated according to the recommendation; a treatment recommendation that is a recommendation regarding use of at least one of a cosmetic product and a dermatological product; at least one of the cosmetic product and the dermatological product is one of a makeup product, a care product, a hair product, a skin product, and a sun exposure product; a treatment recommendation that is a recommendation regarding application of said at least one of the cosmetic product and the dermatological product to the external portion; providing product ordering information along with the treatment recommendation; providing the treatment recommendation to at least one of the individual and a treatment provider; scanned image data includes data regarding color of said transfer image; scanning that includes emitting light from the scanner onto the transfer member, as recited in column 3, lines 10-20; analyzing the external portion, wherein the analyzing of the external portion is performed by a trained person; an external portion that includes skin wherein the cosmetic product is foundation makeup; and storing information relating to the grade in a database.

Rigg et al. do not disclose an optical image scanner. However, Dusserre teach telemedicine with optical imaging. Thus, it would be obvious to one with ordinary skill in the art at the time the invention was made to further provide optical image scanning in the system of Rigg et al. for the purpose of obtaining more information. There are numerous hand-held optical scanners and it would be obvious to provide the system of Rigg et al. with an optical image scanner for the purpose of enhanced images providing more representative data.

Rigg et al. do not disclose placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. However, Groh teaches to scan a transfer member with an adhesive Kawashima et al. disclose tacky tape as a transfer member for observing skin through a scanner. Therefore, it would be obvious to one with ordinary skill in the art to provide the system of Groh with tacky tape for many reasons such the tacky tape allows for a one step process vs. Groh which requires a two step process: first applying the glue and then the slide. Thus, this modification makes the process faster and easier to perform. Furthermore, it can also be construed as an obvious alternative to use either a two-step glue process or a tacky tape since the same function of obtaining a skin sample is achieved. Therefore, it would be obvious to further include scanning transfer members in the system of Rigg et al. for the purpose of obtaining additional patient information.

Additionally, placing the adhesive material of the transfer member in contact with adhesive material of a second transfer member and separating the transfer members to transfer a portion of the skin cells to the second transfer member wherein the transfer member is placed in contact with an external body portion including a cosmetic product applied thereto, wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product; an external portion that includes lips and wherein the cosmetic product is one of a lip care product and a lip makeup product; a transfer member that is formed of fabric; a

transfer member that is an article of clothing; a transfer member is a sheet of material, and wherein the process includes placing the sheet of material in contact with lips of the individual and transferring a lip product from the lips to the sheet of material, wherein the lip product is lipstick; an external portion that is located on the lips of the individual; transferring a questionnaire answers from the first location to the second location, at least some of the questionnaire answers being related to at least one of a condition of the external portion and the product applied to the external body portion; a transfer member that is placed in contact with an external body portion including a cosmetic product applied thereto, and wherein the scanned image data is representative of at least one characteristic of the cosmetic product; and providing a grade indicative of at least one of the condition and performance of the product, they are features/modification that would be obvious to one with ordinary skill in the art at the time the invention was made. Applicant's specification discloses numerous transfer members and external portions and does not demonstrate criticality for any particular transfer member or external portion. Thus, they can be considered equivalents. Moreover, any products applied would further be obvious as to correspond to the particular external portion as necessary to obtain a quality image scan. It would also be obvious to incorporate a flat scanner to include the ability to obtain other cosmetic information and provide additional products.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: FR 07274996; "My Sweet Baby Zachary" by Susan Holstine (5/10/98); Internet citation of Presentation #135 by La Rosa and "MU unveils pilot program for distance plant diagnosis" (12/15/98).

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.

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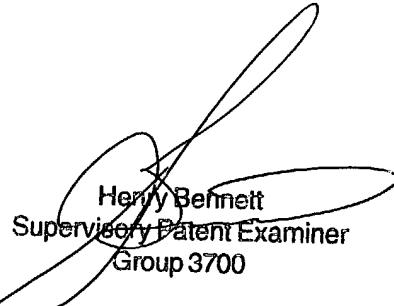
In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO

  
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